

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Shingo KURAMOCHI Confirmation No. 2672
Appln No. : 09/970,968 Group Art Unit: 2162
Filed : October 3, 2001 Examiner: J. B. Fleurantin
For : SYSTEM FOR MANAGING OBJECTS BASED ON POSITION DATA

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
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Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer dated September 7, 2006, the period for reply extending until November 7, 2006.

The Examiner maintains the grounds of rejection advanced in the final rejection of claims 1-20 and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On the Page 16, section 10, the Examiner maintains that NAITO discloses the recited editing means of claim 1 at col. 12, lines 35-41. Appellant disagrees. The recited editing means includes e.g., operable portions of the device 14 and equivalents thereof of Appellant's invention for editing the coordinate data of a new object to be managed or when the object to be managed is being moved to a new location. See page 12, line 28 to page 13, line 5 and page 17, line 26 to page 18, line 7 of the instant specification. In contrast, the noted language of NAITO merely discloses the following:

After the host computer 50 of the communication host apparatus 16 (see FIG. 1) receives the disaster information data, it updates the contents of the database 52 based on the received information. When possible, the communication host apparatus 16 is preferably provided at the facility 90 in charge of disaster response because this makes it possible to save the time otherwise required for transferring/receiving information to/from the facility.

While the above-noted language discusses how a database can be updated, this is not the same as an editing means for editing the coordinate data of a new object to be managed or when the object to be managed is being moved to a new location. Furthermore, the Examiner has not explained how the above-noted language can be read to disclose or suggest an editing means for editing the coordinate data of a new object to be managed or when the object to be managed is being moved to a new location.

Second Issue

On the Page 17, section 10, the Examiner also asserts that col. 2, line 25-28 and col. 3, lines 16-61 of NAITO discloses the recited data communication means of claim 1. Appellant disagrees. The language at col. 2, lines 21-34 of NAITO merely discloses the following:

According to the present invention, the position information data indicative of the current position of the portable terminal detected by the current position detecting means are supplied to the communication host apparatus by the communication means, and in response to the position information data the host computer of the communication host apparatus transmits appropriate data to the portable terminal. The data processing means executes predetermined data processing based upon the information received from the host computer, and the display means displays an image corresponding to data obtained by the data processing on the screen thereof. Consequently, the user of the portable terminal can obtain appropriate information regarding circumstances at his or her location.

While the above-noted language discusses how position data of a portable terminal can be transmitted to a host computer, this is not the same as a data communication means for transferring only a selected database from the host computer to the portable terminal machine so that only information about the object to be managed and physical surrounding attributes is transferred to the portable terminal. Nor has the Examiner explained how such language can be interpreted to disclose or suggest this feature.

Third Issue

On page 18, section 10, the Examiner acknowledges that NAITO and KOBAYASHI fail to disclose a database in which position data of an object to be managed is stored in relation to attribute data of the object to be managed used

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for identifying the object to be managed, wherein the position data includes coordinate data comprising starting points "X" and "Y" and end points "X" and "Y" for each object to be managed, but maintains that this is taught on col. 4, lines 40-46 of INAKI. Appellant disagrees. The language at col. 4, lines 40-46 of INAKI merely discloses the following:

The element manager 4 manages data SX, SY, EX and EY indicating a specified range for an object, and data T indicating the type of the object, such data is referred to as object management data OD and is shown in FIG. 2. The specified object range data SX, SY, EX and EY are represented by data on the coordinates for the start points X and Y and data on the coordinates for the end points X and Y.

While the above-noted language discusses how range data can be represented with X/Y coordinates, this is not the same as a database in which position data of an object to be managed is stored in relation to attribute data of the object to be managed used for identifying the object to be managed, wherein the position data includes coordinate data comprises starting points "X" and "Y" and end points "X" and "Y" for each object to be managed.

Fourth Issue

In section 10, the Examiner makes numerous assertions of obviousness in justifying the combination of NAITO, KOBAYASHI and INAKI. However, the Examiner provides only conclusions of obviousness and neglects to set forth any prior art basis for combining the teachings of the applied documents. In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the

art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As noted above and in the Appeal Brief, each of the applied documents is silent with regard to a number of recited features and each of the documents relates to information systems which function in different manners. Moreover, none of the documents teaches or suggests modifying the structure or operation of either NAITO, KOBAYASHI and INAKI in the manner asserted by the Examiner.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Appellant submits that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify NAITO to include features of KOBAYASHI and INAKI in the manner asserted by the Examiner. That is, Appellant submits that because the Examiner has not set forth any basis or reason found in the art of record for combining these documents, the instant rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Appellant submits that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Appellant's disclosure and the application of impermissible hindsight.

CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-20 under 35 U.S.C. §103(a). Furthermore, the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal.

P26829.A09

The Commissioner is hereby authorized to charge any fees necessary for consideration of this paper to deposit account No. 09-0457.

Respectfully submitted,
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November 7, 2006
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